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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/678,295 | 10/02/2000 | Mathias Entenmann | 12964.15 | 4137 |
| 27683 | 7590 | 03/08/2007 | EXAMINER | |
| HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202 | | | TRAN, HAI | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 3693 |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 03/08/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/678,295 | ENTENMANN, MATHIAS | |
| | Examiner Hai Tran | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 November 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4, 7, 9, 10, 12-19 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4, 7, 9, 10, 12-19, and 22-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Acknowledgements

1. The examiner for this application has changed. Please indicate Examiner Hai Tran as the examiner of record in all future correspondences.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 14, 2006 has been entered.
3. This is the communication in response to the Amendments and Remarks and Request for Continued Examination filed by the applicant on November 14, 2006 for its application case 09/678,295, titled: "Method Of Effecting Cashless Payments And A System For Implementing The Method".
4. Claims 1, 3, 18 and 19 have been amended to add the limitations of claims 11, 5, 21, and 33 respectively. Claims 5, 6, 8, 11, 20, 21, and 33-45 have been cancelled. Claims 2, 4, 7, 9, 10, 12, 13-17, and 22-32 have been maintained in their previous form.
5. Claims 1-4, 7, 9, 10, 12-19, and 22-32 are pending in this case.

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6. This application claims benefit of PCT/EP00/00772 filed on February 1, 2000.

Response to Arguments

7. Applicant's arguments for claims 1, 3, 18 and 19 filed on November 14, 2006 have been fully considered but they are not persuasive.

8. In response to the Final Office Action of 06/19/2006, Applicant amended independent claims 1, 3, 18 and 19 by adding the limitations of dependent claims 11, 5, 21 and 33 respectively and hence the previous rejection is not applicable to the amended claims. Applicant argues that the applied references (Hultgren and Musa) are defective in establishing a prima facie case of obviousness and the combination of Hultgren in view of Musa can not be applied to the amended claims under 35 U.S.C. 103(a) because the combination of the cited prior arts does not render obvious the subject matter of the claims as a whole. The Applicant also argues that the previous rejection of obviousness is based upon improper hindsight reasoning and hence is not applicable to the amended claims.

9. In response to the Applicant's arguments, Examiner reviewed the previous Office Actions of 10/02/2001, 07/17/2003 and 06/19/2006. Examiner believes that the records are clear with respect to the prima facie of obviousness and improper hindsight reasoning matters. The added limitations to the independent claims did not result in a major difference to the claims. Examiner determines that the previous rejections are still applicable to the amended claims, and hence they are rejected under the same rationale provided in the previous Office Actions.

10. With regard to amended claims 1, 3 and apparatus claims 18 and 19, a method and/or apparatus of effecting a cashless payment transaction, by means of a merchant station characterized by a merchant station identification code (see 70 merchant terminal, page 7, lines 5-9; also see merchant's account, page 8, lines 13-16 or merchant identifier, page 9, lines 2-4), a mobile cell phone 60 and a comparing device 3, which comprises a transaction data memory device (see transaction record generator – 206-1; page 11, lines 5-11), a merchant checking device transfer 206 (see coordinate module) for checking the identification codes of the merchant stations authorized for this method, and a subscriber checking device (verification unit 204-3) for checking the identification codes of the smart cards authorized for this method and which is connected to account (see pages 6-20). Transmitting additional supplementary transaction data to the comparing device or mobile cell phone from the merchant station (see page 15, 2nd paragraph; figures 3b/332/342). Terminating the transaction if the confirmation information is not given within a predetermined time after transmitting the information from the merchant station to the comparing device (see page 21, lines 18-20; figures 4-4B). A subscriber checking device in which is held the identification code of each mobile cell phone and the account number associated therewith in the account keeping device (see verification unit 204-3, page 11, line 4), and a control device for transmitting to the account keeping device the account number corresponding to the identification code, on the basis of the information in the subscriber checking device, rather than the identification code of the mobile cell phone (see merchant communication module, page 10, lines 29-4 of page 11). A merchant checking device

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in which is held the identification code of each merchant station and the account number associated therewith in the account keeping device (verification unit 202-4, page 10, line 25), wherein the control device transmits to the account keeping device the account number corresponding to the identification code, on the basis of the information in the merchant memory device, rather than the identification code of the merchant station (see customer communication module, page 10, lines 21-27).

11. Hultgren discloses all the limitations of the invention, but fails to disclose a SMART card characterized by an identification code identifying it.

12. Musa discloses a cellular phone which uses a smart card 5 (see figure 1) that is characterized by an identification code identifying it (see Musa column 2, lines 45-59). It would have been obvious for artisan of ordinary skill at the time of the invention to substitute the cellular phone in the Hultgren invention with the phone in Musa because an artisan of ordinary skill at the time of the invention would have considered the modification a substitution of art equivalence in as much as both cellular phone in this aspect of the invention are relating to identification of the user. Thus under normal engineering design practices, an artisan or ordinary skill in the art would recognize the notoriously old and well known combination of a smart card and cell phone as a cost effective means of user identification. Thus such a substitution would have been an obvious design choice to one of ordinary skill in the art.

13. Examiner notes that the Applicant has not asserted any arguments of dependent claims 2, 4, 7, 9, 10, 12, 13-17, and 22-32, and the Examiner respectfully disagrees with those reasons for the amended claims and hence all the aforesaid claims also.

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14. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

15. Claims 1-4, 7, 9, 10, 12-19, and 22-32 are rejected.

16. The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7364. The examiner can normally be reached on M-F, 9-4 PM.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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